

REMARKS

Amendments

Amendments to the Claims

To assist the Examiner in properly considering each and every limitation of the claims, Applicant has amended claims 11, 21 and 36 to more particularly point out the limitations of the claimed invention. No new matter has been added as a result of these amendments.

Rejections

Rejections under 35 U.S.C. § 103

Claims 11-18, 21-32, 36, 37, 43-48, 50-52 and 58-60

Claims 11-18, 21-32, 36, 37, 43-48, 50-52 and 58-60 stand rejected under 35 U.S.C. § 103(a) as being obvious over U.S. Patent 5,699,107 to Lawler et al. in view of U.S. Patent 5,659,653 to Diehl et al., and U.S. Patent 5,859,662 to Cragun et al.

Applicant respectfully submits that the combination of Lawler, Diehl and Cragun cannot render Applicant's invention obvious because the combination does not teach each and every element of the invention as claimed in claims 11-18, 21-32, 36, 37, 43-48, 50-52 and 58-60.

Lawler discloses scheduling a reminder to notify a viewer of the broadcast of a program previously selected by the user from an electronic program guide (EPG). The EPG and the reminder are generated remotely from the viewer.

Diehl discloses a system that extracts information from a broadcast signal to set a VCR to record a program when the user presses a "learn" button during an advertisement for the program. The advertisement, broadcast signal and information are generated remotely from the viewer.

Cragun discloses a system local to a viewer that searches text in a broadcast signal for keywords or phrases input by a user. When in an automatic scan mode, the system saves the corresponding segment of the broadcast program for later use by the viewer but does not notify the user that a matching

segment has been found. Instead, the user accesses the list of saved segments when the user manually activates the system. When in a manual search/edit mode, Cragun's system searches the previously-saved program and notifies the viewer when it finds a matching segment.

Applicant respectfully submits that there is no suggestion or motivation for the Examiner's combination of Lawler, Diehl and Cragun. The Examiner has asserted that it would have been obvious to modify the reminder system of Lawler to issue a record command after viewing an advertisement for an upcoming program, as in Diehl. However, the Examiner's combination would change the principle of operation of each reference, and therefore the teachings of the references are not sufficient to render the claims *prima facie* obvious. (MPEP 2143.01). Lawler discloses that a user sets a reminder through an illustrated program guide by selecting a Remind button within a future program options menu. Lawler does not teach or suggest any functionality for setting a reminder outside the context of the program guide. Modifying Lawler's reminder system to operate during a broadcast of an advertisement (i.e. independent of the program guide) would alter the principal of operation of Lawler's system. Such a substantial reconstruction and redesign would require a change in the basic principle of upon which Lawler is based, which is to provide reminder functionality within the illustrated program guide. In addition, Diehl is directed to simplifying programming of a VCR by allowing for impulse programming while viewing advertisements. Diehl does not teach or suggest implementing the programming feature within a program guide menu. Incorporating Diehl's impulse programming into the context of Lawler's program guide would only further complicate a user's efforts in programming, contra to Diehl's stated purpose of simplification. Thus, such a modification would require a substantial change in Diehl's principle of operation. Therefore, there is no suggestion or motivation in the references or the art as a whole, for the Examiner's combination.

The Examiner's proposed combination would require each reference to be improperly modified. Applicant respectfully reminds the Examiner that the invention as a whole must be considered. Because nothing in the prior art

suggests the combination or provides a reasonable expectation of success that the combination will work, it appears the Examiner has deconstructed Applicant's claims into their constituent elements, and then selected various elements from the prior art to create a piecemeal reconstruction of Applicant's invention without considering the claimed invention as a whole. Such deconstruction of the claimed invention is improper.

Furthermore, neither the references or the combination teach or suggest a first notification that is issued in response to a first signal generated by a viewer during a broadcast of an advertisement of an upcoming program and that presents a menu to the viewer comprising indications of viewer interest and disinterest in viewing the broadcast of the program as claimed by Applicant. In particular, none of the references teach or suggest presenting a menu in response to a signal generated by a viewer during broadcast of an advertisement. Additionally, neither the references or the combination teach or suggest a second signal indicating a viewer menu selection that is generated in response to the first notification as claimed by Applicant.

Because there is no suggestion or motivation for the combination of Lawler, Diehl and Cragun, and also because the combination fails provide teach or suggest each and every element of Applicant's invention as claimed in pending claims 11-18, 21-32, 36, 37, 43-48, 50-52 and 58-60, Applicant respectfully requests the withdrawal of the rejection of the pending claims under 35 U.S.C. § 103(a) over the combination.

Claims 49 and 57

Claims 49 and 57 stand rejected under 35 U.S.C. § 103(a) over the combination of Lawler, Diehl and Cragun in further view of Hendricks, U.S. Patent 5,990,927. Applicant respectfully submits that the combination cannot render Applicant's invention obvious because there is no suggestion or motivation for the base combination of Lawler, Diehl and Cragun and nothing in Hendricks provides a proper motivation for the base combination. Furthermore, claims 49 and 57 depend from claims 21 and 36, respectively, and Hendricks does not teach the claimed limitations that are missing from the base

combination. Therefore, the combination of Lawler, Diehl, Cragun and Hendricks cannot render obvious claims 49 and 57, and Applicant respectfully requests the withdrawal of the rejection of the claims under 35 U.S.C. § 103(a) over the combination.

SUMMARY

Claims 11-18, 21-32, 36-37, 43-52 and 57-60 are currently pending. In view of the foregoing amendments and remarks, Applicant respectfully submits that the pending claims are in condition for allowance. Applicant respectfully requests reconsideration of the application and allowance of the pending claims.

If the Examiner determines the prompt allowance of these claims could be facilitated by a telephone conference, the Examiner is invited to contact Scott Heilesen at (408) 720-8300.


Deposit Account Authorization

Authorization is hereby given to charge our Deposit Account No. 02-2666 for any charges that may be due. Furthermore, if an extension is required, then Applicant hereby requests such extension.

Respectfully submitted,

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